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In re Application of	:	DECISION ON
Downes et al	:	
Application No.: 10/535,041	:	
PCT No.: PCT/US2003/036123	:	
Application No: 10/535,041	:	
Int. Filing Date: 14 November 2003	:	PETITION UNDER
Priority Date: 15 November 2002	:	
Attorney's Docket No.: SALK3130-1J	:	
For: NON-STEROIDAL FARNESOID X	:	
RECEPTOR MODULATORS	:	37 CFR 1.47(a)

This is in response to the "December 28, 2005" filed on 28 December 2005. The petition fee of \$200.00 has charged to Deposit Account No. 50-0872.

BACKGROUND

On 14 November 2003, applicants filed international application PCT/US2003/036123, which claimed priority to an earlier application filed 15 November 2002.

On 13 May 2005, applicants filed a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 28 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two (2) months from the date of this notice or by 32 months from the priority date for the application, whichever is later, in order to avoid abandonment of the national stage application.

On 28 December 2005, applicants filed a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS," which included, *inter alia*, a petition under 37 CFR 1.47, an executed declaration signed by Michael R. Downes and Ronald Evans on their behalf and on the behalf of the non-signing inventors, and declaration by Sheila R. Kirschenbaum.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the

declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1), (2) - (4) of 37 CFR 1.47(a) but not item (3) under 37 CFR 1.47(a).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding requirement (2), the averments of Sheila R. Kirschenbaum are sufficient to support a finding that the nonsigning inventors, Hughes, Nicolaou and Roecker refuse to sign because a copy of the patent application and declaration were sent to Dr. Fitting, Chief Patent Counsel to The Scripps Research Institute and the legal representative of the three nonsigning inventors, and in a telephone conversion on October 26, 2005 he acknowledge he received the letter. On December 5, 2005 Sheila spoke with Jennifer Dyer, Director of Technology Development at The Scripps Research Institute, and she informed Sheila that the inventors would not be signing the Declaration. This was later confirmed with a phone conversation with Dr. Fitting on December 14, 2005.

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventors in the petition.

Regarding requirement (4), petitioner has provided an executed declaration signed by Mr. Michael R. Downes and Ronald M. Evans on their behalf and on the behalf of the nonsigning joint inventors Ronald M. Evans, Kyriacos C Nicolaou, and Anthony J Roecker.

Consequently, the petition has not met all the items under 37 CFR 1.47(a).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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